

Calendar No. 101

107TH CONGRESS
1ST SESSION

S. 407

[Report No. 107–46]

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

IN THE SENATE OF THE UNITED STATES

FEBRUARY 27, 2001

Mr. LEAHY (for himself and Mr. HATCH) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

JULY 25, 2001

Reported by Mr. LEAHY, with an amendment

[Strike out all after the enacting clause and insert the part printed in *italic*]

A BILL

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the “Madrid Protocol Imple-
3 mentation Act”.

4 **SEC. 2. PROVISIONS TO IMPLEMENT THE PROTOCOL RE-**
5 **LATING TO THE MADRID AGREEMENT CON-**
6 **CERNING THE INTERNATIONAL REGISTRA-**
7 **TION OF MARKS.**

8 The Act entitled “An Act to provide for the registra-
9 tion and protection of trademarks used in commerce; to
10 carry out the provisions of certain international conven-
11 tions; and for other purposes”; approved July 5, 1946; as
12 amended (15 U.S.C. 1051 and following) (commonly re-
13 ferred to as the “Trademark Act of 1946”) is amended
14 by adding after section 51 the following new title:

15 **“TITLE XII—THE MADRID PROTOCOL**

16 **“SEC. 60. DEFINITIONS.**

17 **“For purposes of this title:**

18 **“(1) MADRID PROTOCOL.—**The term ‘Madrid
19 Protocol’ means the Protocol Relating to the Madrid
20 Agreement Concerning the International Registra-
21 tion of Marks, adopted at Madrid, Spain, on June
22 27, 1989.

23 **“(2) BASIC APPLICATION.—**The term ‘basic ap-
24 plication’ means the application for the registration
25 of a mark that has been filed with an Office of a
26 Contracting Party and that constitutes the basis for

1 an application for the international registration of
2 that mark.

3 “(3) BASIC REGISTRATION.—The term ‘basic
4 registration’ means the registration of a mark that
5 has been granted by an Office of a Contracting
6 Party and that constitutes the basis for an applica-
7 tion for the international registration of that mark.

8 “(4) CONTRACTING PARTY.—The term ‘Con-
9 tracting Party’ means any country or inter-govern-
10 mental organization that is a party to the Madrid
11 Protocol.

12 “(5) DATE OF RECORDAL.—The term ‘date of
13 recordal’ means the date on which a request for ex-
14 tension of protection that is filed after an inter-
15 national registration is granted is recorded on the
16 International Register.

17 “(6) DECLARATION OF BONA FIDE INTENTION
18 TO USE THE MARK IN COMMERCE.—The term ‘dec-
19 laration of bona fide intention to use the mark in
20 commerce’ means a declaration that is signed by the
21 applicant for, or holder of, an international registra-
22 tion who is seeking extension of protection of a mark
23 to the United States and that contains a statement
24 that—

1 “(A) the applicant or holder has a bona
2 fide intention to use the mark in commerce;

3 “(B) the person making the declaration be-
4 lieves himself or herself, or the firm, corpora-
5 tion, or association in whose behalf he or she
6 makes the declaration, to be entitled to use the
7 mark in commerce; and

8 “(C) no other person, firm, corporation, or
9 association, to the best of his or her knowledge
10 and belief, has the right to use such mark in
11 commerce either in the identical form of the
12 mark or in such near resemblance to the mark
13 as to be likely, when used on or in connection
14 with the goods of such other person, firm, cor-
15 poration, or association, to cause confusion, or
16 to cause mistake, or to deceive.

17 “(7) EXTENSION OF PROTECTION.—The term
18 ‘extension of protection’ means the protection result-
19 ing from an international registration that extends
20 to a Contracting Party at the request of the holder
21 of the international registration, in accordance with
22 the Madrid Protocol.

23 “(8) HOLDER OF AN INTERNATIONAL REG-
24 ISTRATION.—A ‘holder’ of an international registra-
25 tion is the natural or juristic person in whose name

1 the international registration is recorded on the
2 International Register.

3 ~~“(9) INTERNATIONAL APPLICATION.—~~The term
4 ‘international application’ means an application for
5 international registration that is filed under the Ma-
6 drid Protocol.

7 ~~“(10) INTERNATIONAL BUREAU.—~~The term
8 ‘International Bureau’ means the International Bu-
9 reau of the World Intellectual Property Organiza-
10 tion.

11 ~~“(11) INTERNATIONAL REGISTER.—~~The term
12 ‘International Register’ means the official collection
13 of such data concerning international registrations
14 maintained by the International Bureau that the
15 Madrid Protocol or its implementing regulations re-
16 quire or permit to be recorded, regardless of the me-
17 dium which contains such data.

18 ~~“(12) INTERNATIONAL REGISTRATION.—~~The
19 term ‘international registration’ means the registra-
20 tion of a mark granted under the Madrid Protocol.

21 ~~“(13) INTERNATIONAL REGISTRATION DATE.—~~
22 The term ‘international registration date’ means the
23 date assigned to the international registration by the
24 International Bureau.

1 “(14) NOTIFICATION OF REFUSAL.—The term
2 ‘notification of refusal’ means the notice sent by an
3 Office of a Contracting Party to the International
4 Bureau declaring that an extension of protection
5 cannot be granted.

6 “(15) OFFICE OF A CONTRACTING PARTY.—The
7 term ‘Office of a Contracting Party’ means—

8 “(A) the office, or governmental entity, of
9 a Contracting Party that is responsible for the
10 registration of marks; or

11 “(B) the common office, or governmental
12 entity, of more than 1 Contracting Party that
13 is responsible for the registration of marks and
14 is so recognized by the International Bureau.

15 “(16) OFFICE OF ORIGIN.—The term ‘office of
16 origin’ means the Office of a Contracting Party with
17 which a basic application was filed or by which a
18 basic registration was granted.

19 “(17) OPPOSITION PERIOD.—The term ‘opposi-
20 tion period’ means the time allowed for filing an op-
21 position in the Patent and Trademark Office, includ-
22 ing any extension of time granted under section 13.

1 **“SEC. 61. INTERNATIONAL APPLICATIONS BASED ON**
2 **UNITED STATES APPLICATIONS OR REG-**
3 **ISTRATIONS.**

4 “The owner of a basic application pending before the
5 Patent and Trademark Office, or the owner of a basic reg-
6 istration granted by the Patent and Trademark Office,
7 who—

8 “(1) is a national of the United States;

9 “(2) is domiciled in the United States; or

10 “(3) has a real and effective industrial or com-
11 mercial establishment in the United States;

12 may file an international application by submitting to the
13 Patent and Trademark Office a written application in
14 such form, together with such fees, as may be prescribed
15 by the Director.

16 **“SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLI-**
17 **CATION.**

18 “Upon the filing of an application for international
19 registration and payment of the prescribed fees, the Direc-
20 tor shall examine the international application for the pur-
21 pose of certifying that the information contained in the
22 international application corresponds to the information
23 contained in the basic application or basic registration at
24 the time of the certification. Upon examination and certifi-
25 cation of the international application, the Director shall

1 transmit the international application to the International
2 Bureau.

3 **“SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION,**
4 **OR EXPIRATION OF A BASIC APPLICATION OR**
5 **BASIC REGISTRATION.**

6 “With respect to an international application trans-
7 mitted to the International Bureau under section 62, the
8 Director shall notify the International Bureau whenever
9 the basic application or basic registration which is the
10 basis for the international application has been restricted,
11 abandoned, or canceled, or has expired, with respect to
12 some or all of the goods and services listed in the inter-
13 national registration—

14 “(1) within 5 years after the international reg-
15 istration date; or

16 “(2) more than 5 years after the international
17 registration date if the restriction, abandonment, or
18 cancellation of the basic application or basic reg-
19 istration resulted from an action that began before
20 the end of that 5-year period.

21 **“SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUB-**
22 **SEQUENT TO INTERNATIONAL REGISTRA-**
23 **TION.**

24 “The holder of an international registration that is
25 based upon a basic application filed with the Patent and

1 Trademark Office or a basic registration granted by the
 2 Patent and Trademark Office may request an extension
 3 of protection of its international registration by filing such
 4 a request—

5 “(1) directly with the International Bureau; or
 6 “(2) with the Patent and Trademark Office for
 7 transmittal to the International Bureau, if the re-
 8 quest is in such form, and contains such transmittal
 9 fee, as may be prescribed by the Director.

10 **“SEC. 65. EXTENSION OF PROTECTION OF AN INTER-**
 11 **NATIONAL REGISTRATION TO THE UNITED**
 12 **STATES UNDER THE MADRID PROTOCOL.**

13 “(a) IN GENERAL.—Subject to the provisions of sec-
 14 tion 68, the holder of an international registration shall
 15 be entitled to the benefits of extension of protection of that
 16 international registration to the United States to the ex-
 17 tent necessary to give effect to any provision of the Madrid
 18 Protocol.

19 “(b) IF UNITED STATES IS OFFICE OF ORIGIN.—
 20 An extension of protection resulting from an international
 21 registration of a mark shall not apply to the United States
 22 if the Patent and Trademark Office is the office of origin
 23 with respect to that mark.

1 **“SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION**
2 **OF PROTECTION OF AN INTERNATIONAL**
3 **REGISTRATION TO THE UNITED STATES.**

4 ~~“(a) REQUIREMENT FOR REQUEST FOR EXTENSION~~
5 ~~OF PROTECTION.—A request for extension of protection~~
6 ~~of an international registration to the United States that~~
7 ~~the International Bureau transmits to the Patent and~~
8 ~~Trademark Office shall be deemed to be properly filed in~~
9 ~~the United States if such request, when received by the~~
10 ~~International Bureau, has attached to it a declaration of~~
11 ~~bona fide intention to use the mark in commerce that is~~
12 ~~verified by the applicant for, or holder of, the international~~
13 ~~registration.~~

14 ~~“(b) EFFECT OF PROPER FILING.—Unless extension~~
15 ~~of protection is refused under section 68, the proper filing~~
16 ~~of the request for extension of protection under subsection~~
17 ~~(a) shall constitute constructive use of the mark, confer-~~
18 ~~ring the same rights as those specified in section 7(c), as~~
19 ~~of the earliest of the following:~~

20 ~~“(1) The international registration date, if the~~
21 ~~request for extension of protection was filed in the~~
22 ~~international application.~~

23 ~~“(2) The date of recordal of the request for ex-~~
24 ~~tension of protection, if the request for extension of~~
25 ~~protection was made after the international registra-~~
26 ~~tion date.~~

1 ~~“(3) The date of priority claimed pursuant to~~
 2 ~~section 67.~~

3 **~~“SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTEN-~~**
 4 **~~SION OF PROTECTION TO THE UNITED~~**
 5 **~~STATES.~~**

6 ~~“The holder of an international registration with an~~
 7 ~~extension of protection to the United States shall be enti-~~
 8 ~~tled to claim a date of priority based on the right of pri-~~
 9 ~~ority within the meaning of article 4 of the Paris Conven-~~
 10 ~~tion for the Protection of Industrial Property if—~~

11 ~~“(1) the international registration contained a~~
 12 ~~claim of such priority; and~~

13 ~~“(2)(A) the international application contained~~
 14 ~~a request for extension of protection to the United~~
 15 ~~States; or~~

16 ~~“(B) the date of recordal of the request for ex-~~
 17 ~~tension of protection to the United States is not~~
 18 ~~later than 6 months after the date of the first reg-~~
 19 ~~ular national filing (within the meaning of article~~
 20 ~~4(A)(3) of the Paris Convention for the Protection~~
 21 ~~of Industrial Property) or a subsequent application~~
 22 ~~(within the meaning of article 4(C)(4) of the Paris~~
 23 ~~Convention).~~

1 **“SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST**
 2 **FOR EXTENSION OF PROTECTION; NOTIFICA-**
 3 **TION OF REFUSAL.**

4 “(a) EXAMINATION AND OPPOSITION.—(1) A request
 5 for extension of protection described in section 66(a) shall
 6 be examined as an application for registration on the Prin-
 7 cipal Register under this Act, and if on such examination
 8 it appears that the applicant is entitled to extension of
 9 protection under this title, the Director shall cause the
 10 mark to be published in the Official Gazette of the Patent
 11 and Trademark Office.

12 “(2) Subject to the provisions of subsection (c), a re-
 13 quest for extension of protection under this title shall be
 14 subject to opposition under section 13. Unless successfully
 15 opposed, the request for extension of protection shall not
 16 be refused.

17 “(3) Extension of protection shall not be refused
 18 under this section on the ground that the mark has not
 19 been used in commerce.

20 “(4) Extension of protection shall be refused under
 21 this section to any mark not registrable on the Principal
 22 Register.

23 “(b) NOTIFICATION OF REFUSAL.—If, a request for
 24 extension of protection is refused under subsection (a), the
 25 Director shall declare in a notification of refusal (as pro-
 26 vided in subsection (c)) that the extension of protection

1 cannot be granted, together with a statement of all
 2 grounds on which the refusal was based.

3 “(e) NOTICE TO INTERNATIONAL BUREAU.—(1)

4 Within 18 months after the date on which the Inter-
 5 national Bureau transmits to the Patent and Trademark
 6 Office a notification of a request for extension of protec-
 7 tion, the Director shall transmit to the International Bu-
 8 reau any of the following that applies to such request:

9 “(A) A notification of refusal based on an ex-
 10 amination of the request for extension of protection.

11 “(B) A notification of refusal based on the fil-
 12 ing of an opposition to the request.

13 “(C) A notification of the possibility that an op-
 14 position to the request may be filed after the end of
 15 that 18-month period.

16 “(2) If the Director has sent a notification of the pos-
 17 sibility of opposition under paragraph (1)(C), the Director
 18 shall, if applicable, transmit to the International Bureau
 19 a notification of refusal on the basis of the opposition, to-
 20 gether with a statement of all the grounds for the opposi-
 21 tion, within 7 months after the beginning of the opposition
 22 period or within 1 month after the end of the opposition
 23 period, whichever is earlier.

24 “(3) If a notification of refusal of a request for exten-
 25 sion of protection is transmitted under paragraph (1) or

1 (2), no grounds for refusal of such request other than
 2 those set forth in such notification may be transmitted to
 3 the International Bureau by the Director after the expira-
 4 tion of the time periods set forth in paragraph (1) or (2),
 5 as the case may be.

6 “(4) If a notification specified in paragraph (1) or
 7 (2) is not sent to the International Bureau within the time
 8 period set forth in such paragraph, with respect to a re-
 9 quest for extension of protection, the request for extension
 10 of protection shall not be refused and the Director shall
 11 issue a certificate of extension of protection pursuant to
 12 the request.

13 “(d) DESIGNATION OF AGENT FOR SERVICE OF
 14 PROCESS.—In responding to a notification of refusal with
 15 respect to a mark, the holder of the international registra-
 16 tion of the mark shall designate, by a written document
 17 filed in the Patent and Trademark Office, the name and
 18 address of a person resident in the United States on whom
 19 may be served notices or process in proceedings affecting
 20 the mark. Such notices or process may be served upon
 21 the person so designated by leaving with that person, or
 22 mailing to that person, a copy thereof at the address speci-
 23 fied in the last designation so filed. If the person so des-
 24 ignated cannot be found at the address given in the last

1 designation, such notice or process may be served upon
2 the Director.

3 **“SEC. 69. EFFECT OF EXTENSION OF PROTECTION.**

4 **“(a) ISSUANCE OF EXTENSION OF PROTECTION.—**

5 Unless a request for extension of protection is refused
6 under section 68, the Director shall issue a certificate of
7 extension of protection pursuant to the request and shall
8 cause notice of such certificate of extension of protection
9 to be published in the Official Gazette of the Patent and
10 Trademark Office.

11 **“(b) EFFECT OF EXTENSION OF PROTECTION.—**

12 From the date on which a certificate of extension of pro-
13 tection is issued under subsection (a)—

14 **“(1) such extension of protection shall have the**
15 **same effect and validity as a registration on the**
16 **Principal Register; and**

17 **“(2) the holder of the international registration**
18 **shall have the same rights and remedies as the**
19 **owner of a registration on the Principal Register.**

20 **“SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO**

21 **THE UNITED STATES ON THE UNDERLYING**

22 **INTERNATIONAL REGISTRATION.**

23 **“(a) EFFECT OF CANCELLATION OF INTERNATIONAL**

24 **REGISTRATION.—**If the International Bureau notifies the
25 Patent and Trademark Office of the cancellation of an

1 international registration with respect to some or all of
2 the goods and services listed in the international registra-
3 tion, the Director shall cancel any extension of protection
4 to the United States with respect to such goods and serv-
5 ices as of the date on which the international registration
6 was canceled.

7 “(b) EFFECT OF FAILURE TO RENEW INTER-
8 NATIONAL REGISTRATION.—If the International Bureau
9 does not renew an international registration, the cor-
10 responding extension of protection to the United States
11 shall cease to be valid as of the date of the expiration of
12 the international registration.

13 “(c) TRANSFORMATION OF AN EXTENSION OF PRO-
14 TECTION INTO A UNITED STATES APPLICATION.—The
15 holder of an international registration canceled in whole
16 or in part by the International Bureau at the request of
17 the office of origin, under article 6(4) of the Madrid Pro-
18 tocol, may file an application, under section 1 or 44 of
19 this Act, for the registration of the same mark for any
20 of the goods and services to which the cancellation applies
21 that were covered by an extension of protection to the
22 United States based on that international registration.
23 Such an application shall be treated as if it had been filed
24 on the international registration date or the date of
25 recordal of the request for extension of protection with the

1 International Bureau, whichever date applies, and, if the
 2 extension of protection enjoyed priority under section 67
 3 of this title, shall enjoy the same priority. Such an applica-
 4 tion shall be entitled to the benefits conferred by this sub-
 5 section only if the application is filed not later than 3
 6 months after the date on which the international registra-
 7 tion was canceled, in whole or in part, and only if the ap-
 8 plication complies with all the requirements of this Act
 9 which apply to any application filed pursuant to section
 10 1 or 44.

11 **“SEC. 71. AFFIDAVITS AND FEES.**

12 “(a) **REQUIRED AFFIDAVITS AND FEES.**—An exten-
 13 sion of protection for which a certificate of extension of
 14 protection has been issued under section 69 shall remain
 15 in force for the term of the international registration upon
 16 which it is based, except that the extension of protection
 17 of any mark shall be canceled by the Director—

18 “(1) at the end of the 6-year period beginning
 19 on the date on which the certificate of extension of
 20 protection was issued by the Director, unless within
 21 the 1-year period preceding the expiration of that 6-
 22 year period the holder of the international registra-
 23 tion files in the Patent and Trademark Office an af-
 24 fidavit under subsection (b) together with a fee pre-
 25 scribed by the Director; and

1 ~~“(2) at the end of the 10-year period beginning~~
 2 ~~on the date on which the certificate of extension of~~
 3 ~~protection was issued by the Director, and at the~~
 4 ~~end of each 10-year period thereafter, unless—~~

5 ~~“(A) within the 6-month period preceding~~
 6 ~~the expiration of such 10-year period the holder~~
 7 ~~of the international registration files in the Pat-~~
 8 ~~ent and Trademark Office an affidavit under~~
 9 ~~subsection (b) together with a fee prescribed by~~
 10 ~~the Director, or~~

11 ~~“(B) within 3 months after the expiration~~
 12 ~~of such 10-year period, the holder of the inter-~~
 13 ~~national registration files in the Patent and~~
 14 ~~Trademark Office an affidavit under subsection~~
 15 ~~(b) together with the fee described in subpara-~~
 16 ~~graph (A) and an additional fee prescribed by~~
 17 ~~the Director.~~

18 ~~“(b) CONTENTS OF AFFIDAVIT.—The affidavit re-~~
 19 ~~ferred to in subsection (a) shall set forth those goods or~~
 20 ~~services recited in the extension of protection on or in con-~~
 21 ~~nection with which the mark is in use in commerce and~~
 22 ~~the holder of the international registration shall attach to~~
 23 ~~the affidavit a specimen or facsimile showing the current~~
 24 ~~use of the mark in commerce, or shall set forth that any~~
 25 ~~nonuse is due to special circumstances which excuse such~~

1 nonuse and is not due to any intention to abandon the
 2 mark. Special notice of the requirement for such affidavit
 3 shall be attached to each certificate of extension of protec-
 4 tion.

5 **“SEC. 72. ASSIGNMENT OF AN EXTENSION OF PROTECTION.**

6 “An extension of protection may be assigned, to-
 7 gether with the goodwill associated with the mark, only
 8 to a person who is a national of, is domiciled in, or has
 9 a bona fide and effective industrial or commercial estab-
 10 lishment either in a country that is a Contracting Party
 11 or in a country that is a member of an intergovernmental
 12 organization that is a Contracting Party.

13 **“SEC. 73. INCONTESTABILITY.**

14 “The period of continuous use prescribed under sec-
 15 tion 15 for a mark covered by an extension of protection
 16 issued under this title may begin no earlier than the date
 17 on which the Director issues the certificate of the exten-
 18 sion of protection under section 69, except as provided in
 19 section 74.

20 **“SEC. 74. RIGHTS OF EXTENSION OF PROTECTION.**

21 “An extension of protection shall convey the same
 22 rights as an existing registration for the same mark, if—

23 “(1) the extension of protection and the exist-
 24 ing registration are owned by the same person;

1 ~~“(2) the goods and services listed in the exist-~~
 2 ~~ing registration are also listed in the extension of~~
 3 ~~protection; and~~

4 ~~“(3) the certificate of extension of protection is~~
 5 ~~issued after the date of the existing registration.”.~~

6 **SEC. 3. EFFECTIVE DATE.**

7 This Act and the amendments made by this Act shall
 8 take effect on the date on which the Madrid Protocol (as
 9 defined in section 60(1) of the Trademark Act of 1946)
 10 enters into force with respect to the United States.

11 **SECTION 1. SHORT TITLE.**

12 *This Act may be cited as the “Madrid Protocol Imple-*
 13 *mentation Act”.*

14 **SEC. 2. PROVISIONS TO IMPLEMENT THE PROTOCOL RE-**
 15 **LATING TO THE MADRID AGREEMENT CON-**
 16 **CERNING THE INTERNATIONAL REGISTRA-**
 17 **TION OF MARKS.**

18 *The Act entitled “An Act to provide for the registration*
 19 *and protection of trademarks used in commerce, to carry*
 20 *out the provisions of certain international conventions, and*
 21 *for other purposes”, approved July 5, 1946, as amended (15*
 22 *U.S.C. 1051 and following) (commonly referred to as the*
 23 *“Trademark Act of 1946”) is amended by adding after sec-*
 24 *tion 51 the following:*

1 “*TITLE XII—THE MADRID PROTOCOL*

2 “**SEC. 60. DEFINITIONS.**

3 *“In this title:*

4 “(1) *BASIC APPLICATION.—The term ‘basic ap-*
 5 *plication’ means the application for the registration*
 6 *of a mark that has been filed with an Office of a Con-*
 7 *tracting Party and that constitutes the basis for an*
 8 *application for the international registration of that*
 9 *mark.*

10 “(2) *BASIC REGISTRATION.—The term ‘basic reg-*
 11 *istration’ means the registration of a mark that has*
 12 *been granted by an Office of a Contracting Party and*
 13 *that constitutes the basis for an application for the*
 14 *international registration of that mark.*

15 “(3) *CONTRACTING PARTY.—The term ‘Con-*
 16 *tracting Party’ means any country or inter-govern-*
 17 *mental organization that is a party to the Madrid*
 18 *Protocol.*

19 “(4) *DATE OF RECORDAL.—The term ‘date of*
 20 *recordal’ means the date on which a request for exten-*
 21 *sion of protection, filed after an international reg-*
 22 *istration is granted, is recorded on the International*
 23 *Register.*

24 “(5) *DECLARATION OF BONA FIDE INTENTION TO*
 25 *USE THE MARK IN COMMERCE.—The term ‘declara-*

tion of bona fide intention to use the mark in commerce’ means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that—

“(A) the applicant or holder has a bona fide intention to use the mark in commerce;

“(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and

“(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

“(6) *EXTENSION OF PROTECTION.*—The term ‘extension of protection’ means the protection resulting from an international registration that extends to the United States at the request of the holder of the inter-

1 *national registration, in accordance with the Madrid*
 2 *Protocol.*

3 “(7) *HOLDER OF AN INTERNATIONAL REGISTRA-*
 4 *TION.*—A ‘holder’ of an international registration is
 5 *the natural or juristic person in whose name the*
 6 *international registration is recorded on the Inter-*
 7 *national Register.*

8 “(8) *INTERNATIONAL APPLICATION.*—*The term*
 9 *‘international application’ means an application for*
 10 *international registration that is filed under the Ma-*
 11 *drid Protocol.*

12 “(9) *INTERNATIONAL BUREAU.*—*The term ‘Inter-*
 13 *national Bureau’ means the International Bureau of*
 14 *the World Intellectual Property Organization.*

15 “(10) *INTERNATIONAL REGISTER.*—*The term*
 16 *‘International Register’ means the official collection of*
 17 *data concerning international registrations main-*
 18 *tained by the International Bureau that the Madrid*
 19 *Protocol or its implementing regulations require or*
 20 *permit to be recorded.*

21 “(11) *INTERNATIONAL REGISTRATION.*—*The term*
 22 *‘international registration’ means the registration of*
 23 *a mark granted under the Madrid Protocol.*

24 “(12) *INTERNATIONAL REGISTRATION DATE.*—
 25 *The term ‘international registration date’ means the*

1 *date assigned to the international registration by the*
 2 *International Bureau.*

3 “(13) *MADRID PROTOCOL.*—*The term ‘Madrid*
 4 *Protocol’ means the Protocol Relating to the Madrid*
 5 *Agreement Concerning the International Registration*
 6 *of Marks, adopted at Madrid, Spain, on June 27,*
 7 *1989.*

8 “(14) *NOTIFICATION OF REFUSAL.*—*The term*
 9 *‘notification of refusal’ means the notice sent by the*
 10 *United States Patent and Trademark Office to the*
 11 *International Bureau declaring that an extension of*
 12 *protection cannot be granted.*

13 “(15) *OFFICE OF A CONTRACTING PARTY.*—*The*
 14 *term ‘Office of a Contracting Party’ means—*

15 “(A) *the office, or governmental entity, of a*
 16 *Contracting Party that is responsible for the reg-*
 17 *istration of marks; or*

18 “(B) *the common office, or governmental en-*
 19 *tity, of more than 1 Contracting Party that is*
 20 *responsible for the registration of marks and is*
 21 *so recognized by the International Bureau.*

22 “(16) *OFFICE OF ORIGIN.*—*The term ‘office of or-*
 23 *igin’ means the Office of a Contracting Party with*
 24 *which a basic application was filed or by which a*
 25 *basic registration was granted.*

1 “(17) *OPPOSITION PERIOD.*—The term ‘opposi-
 2 tion period’ means the time allowed for filing an op-
 3 position in the United States Patent and Trademark
 4 Office, including any extension of time granted under
 5 section 13.

6 **“SEC. 61. INTERNATIONAL APPLICATIONS BASED ON**
 7 **UNITED STATES APPLICATIONS OR REG-**
 8 **ISTRATIONS.**

9 “(a) *IN GENERAL.*—The owner of a basic application
 10 pending before the United States Patent and Trademark Of-
 11 fice, or the owner of a basic registration granted by the
 12 United States Patent and Trademark Office may file an
 13 international application by submitting to the United
 14 States Patent and Trademark Office a written application
 15 in such form, together with such fees, as may be prescribed
 16 by the Director.

17 “(b) *QUALIFIED OWNERS.*—A qualified owner, under
 18 subsection (a), shall—

19 “(1) be a national of the United States;

20 “(2) be domiciled in the United States; or

21 “(3) have a real and effective industrial or com-
 22 mercial establishment in the United States.

1 **“SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLI-**
 2 **CATION.**

3 “(a) *CERTIFICATION PROCEDURE.*—Upon the filing of
 4 an application for international registration and payment
 5 of the prescribed fees, the Director shall examine the inter-
 6 national application for the purpose of certifying that the
 7 information contained in the international application cor-
 8 responds to the information contained in the basic applica-
 9 tion or basic registration at the time of the certification.

10 “(b) *TRANSMITTAL.*—Upon examination and certifi-
 11 cation of the international application, the Director shall
 12 transmit the international application to the International
 13 Bureau.

14 **“SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION,**
 15 **OR EXPIRATION OF A BASIC APPLICATION OR**
 16 **BASIC REGISTRATION.**

17 “With respect to an international application trans-
 18 mitted to the International Bureau under section 62, the
 19 Director shall notify the International Bureau whenever the
 20 basic application or basic registration which is the basis
 21 for the international application has been restricted, aban-
 22 doned, or canceled, or has expired, with respect to some or
 23 all of the goods and services listed in the international
 24 registration—

25 “(1) within 5 years after the international reg-
 26 istration date; or

1 “(2) more than 5 years after the international
 2 registration date if the restriction, abandonment, or
 3 cancellation of the basic application or basic registra-
 4 tion resulted from an action that began before the end
 5 of that 5-year period.

6 **“SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUB-**
 7 **SEQUENT TO INTERNATIONAL REGISTRA-**
 8 **TION.**

9 “The holder of an international registration that is
 10 based upon a basic application filed with the United States
 11 Patent and Trademark Office or a basic registration grant-
 12 ed by the Patent and Trademark Office may request an ex-
 13 tension of protection of its international registration by fil-
 14 ing such a request—

15 “(1) directly with the International Bureau; or
 16 “(2) with the United States Patent and Trade-
 17 mark Office for transmittal to the International Bu-
 18 reau, if the request is in such form, and contains such
 19 transmittal fee, as may be prescribed by the Director.

20 **“SEC. 65. EXTENSION OF PROTECTION OF AN INTER-**
 21 **NATIONAL REGISTRATION TO THE UNITED**
 22 **STATES UNDER THE MADRID PROTOCOL.**

23 “(a) *IN GENERAL.*—Subject to the provisions of section
 24 68, the holder of an international registration shall be enti-
 25 tled to the benefits of extension of protection of that inter-

1 *national registration to the United States to the extent nec-*
 2 *essary to give effect to any provision of the Madrid Protocol.*

3 “(b) *IF THE UNITED STATES IS OFFICE OF ORIGIN.*—
 4 *Where the United States Patent and Trademark Office is*
 5 *the office of origin for a trademark application or registra-*
 6 *tion, any international registration based on such applica-*
 7 *tion or registration cannot be used to obtain the benefits*
 8 *of the Madrid Protocol in the United States.*

9 “**SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION**
 10 **OF PROTECTION OF AN INTERNATIONAL REG-**
 11 **ISTRATION TO THE UNITED STATES.**

12 “(a) *REQUIREMENT FOR REQUEST FOR EXTENSION OF*
 13 *PROTECTION.*—*A request for extension of protection of an*
 14 *international registration to the United States that the*
 15 *International Bureau transmits to the United States Patent*
 16 *and Trademark Office shall be deemed to be properly filed*
 17 *in the United States if such request, when received by the*
 18 *International Bureau, has attached to it a declaration of*
 19 *bona fide intention to use the mark in commerce that is*
 20 *verified by the applicant for, or holder of, the international*
 21 *registration.*

22 “(b) *EFFECT OF PROPER FILING.*—*Unless extension of*
 23 *protection is refused under section 68, the proper filing of*
 24 *the request for extension of protection under subsection (a)*
 25 *shall constitute constructive use of the mark, conferring the*

1 *same rights as those specified in section 7(c), as of the ear-*
 2 *liest of the following:*

3 “(1) *The international registration date, if the*
 4 *request for extension of protection was filed in the*
 5 *international application.*

6 “(2) *The date of recordal of the request for exten-*
 7 *sion of protection, if the request for extension of pro-*
 8 *tection was made after the international registration*
 9 *date.*

10 “(3) *The date of priority claimed pursuant to*
 11 *section 67.*

12 **“SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTEN-**
 13 **SION OF PROTECTION TO THE UNITED**
 14 **STATES.**

15 *“The holder of an international registration with a re-*
 16 *quest for an extension of protection to the United States*
 17 *shall be entitled to claim a date of priority based on a right*
 18 *of priority within the meaning of Article 4 of the Paris*
 19 *Convention for the Protection of Industrial Property if—*

20 “(1) *the request for extension of protection con-*
 21 *tains a claim of priority; and*

22 “(2) *the date of international registration or the*
 23 *date of the recordal of the request for extension of pro-*
 24 *tection to the United States is not later than 6*
 25 *months after the date of the first regular national fil-*

1 *ing (within the meaning of Article 4(A)(3) of the*
 2 *Paris Convention for the Protection of Industrial*
 3 *Property) or a subsequent application (within the*
 4 *meaning of Article 4(C)(4) of the Paris Convention*
 5 *for the Protection of Industrial Property).*

6 **“SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST**
 7 **FOR EXTENSION OF PROTECTION; NOTIFICA-**
 8 **TION OF REFUSAL.**

9 *“(a) EXAMINATION AND OPPOSITION.—(1) A request*
 10 *for extension of protection described in section 66(a) shall*
 11 *be examined as an application for registration on the Prin-*
 12 *cipal Register under this Act, and if on such examination*
 13 *it appears that the applicant is entitled to extension of pro-*
 14 *tection under this title, the Director shall cause the mark*
 15 *to be published in the Official Gazette of the United States*
 16 *Patent and Trademark Office.*

17 *“(2) Subject to the provisions of subsection (c), a re-*
 18 *quest for extension of protection under this title shall be*
 19 *subject to opposition under section 13.*

20 *“(3) Extension of protection shall not be refused on*
 21 *the ground that the mark has not been used in commerce.*

22 *“(4) Extension of protection shall be refused to any*
 23 *mark not registrable on the Principal Register.*

24 *“(b) NOTIFICATION OF REFUSAL.—If, a request for ex-*
 25 *tension of protection is refused under subsection (a), the Di-*

1 rector shall declare in a notification of refusal (as provided
 2 in subsection (c)) that the extension of protection cannot
 3 be granted, together with a statement of all grounds on
 4 which the refusal was based.

5 “(c) NOTICE TO INTERNATIONAL BUREAU.—(1) With-
 6 in 18 months after the date on which the International Bu-
 7 reau transmits to the Patent and Trademark Office a notifi-
 8 cation of a request for extension of protection, the Director
 9 shall transmit to the International Bureau any of the fol-
 10 lowing that applies to such request:

11 “(A) A notification of refusal based on an exam-
 12 ination of the request for extension of protection.

13 “(B) A notification of refusal based on the filing
 14 of an opposition to the request.

15 “(C) A notification of the possibility that an op-
 16 position to the request may be filed after the end of
 17 that 18-month period.

18 “(2) If the Director has sent a notification of the possi-
 19 bility of opposition under paragraph (1)(C), the Director
 20 shall, if applicable, transmit to the International Bureau
 21 a notification of refusal on the basis of the opposition, to-
 22 gether with a statement of all the grounds for the opposition,
 23 within 7 months after the beginning of the opposition pe-
 24 riod or within 1 month after the end of the opposition pe-
 25 riod, whichever is earlier.

1 “(3) *If a notification of refusal of a request for exten-*
2 *sion of protection is transmitted under paragraph (1) or*
3 *(2), no grounds for refusal of such request other than those*
4 *set forth in such notification may be transmitted to the*
5 *International Bureau by the Director after the expiration*
6 *of the time periods set forth in paragraph (1) or (2), as*
7 *the case may be.*

8 “(d) *DESIGNATION OF AGENT FOR SERVICE OF PROC-*
9 *ESS.—In responding to a notification of refusal with re-*
10 *spect to a mark, the holder of the international registration*
11 *of the mark may designate, by a document filed in the*
12 *United States Patent and Trademark Office, the name and*
13 *address of a person residing in the United States on whom*
14 *notices or process in proceedings affecting the mark may*
15 *be served. Such notices or process may be served upon the*
16 *person designated by leaving with that person, or mailing*
17 *to that person, a copy thereof at the address specified in*
18 *the last designation filed. If the person designated cannot*
19 *be found at the address given in the last designation, or*
20 *if the holder does not designate by a document filed in the*
21 *United States Patent and Trademark Office the name and*
22 *address of a person residing in the United States for service*
23 *of notices or process in proceedings affecting the mark, the*
24 *notice or process may be served on the Director.*

1 **“SEC. 69. EFFECT OF EXTENSION OF PROTECTION.**

2 “(a) *ISSUANCE OF EXTENSION OF PROTECTION.*—Un-
 3 less a request for extension of protection is refused under
 4 section 68, the Director shall issue a certificate of extension
 5 of protection pursuant to the request and shall cause notice
 6 of such certificate of extension of protection to be published
 7 in the Official Gazette of the United States Patent and
 8 Trademark Office.

9 “(b) *EFFECT OF EXTENSION OF PROTECTION.*—From
 10 the date on which a certificate of extension of protection
 11 is issued under subsection (a)—

12 “(1) such extension of protection shall have the
 13 same effect and validity as a registration on the Prin-
 14 cipal Register; and

15 “(2) the holder of the international registration
 16 shall have the same rights and remedies as the owner
 17 of a registration on the Principal Register.

18 **“SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO**
 19 **THE UNITED STATES ON THE UNDERLYING**
 20 **INTERNATIONAL REGISTRATION.**

21 “(a) *EFFECT OF CANCELLATION OF INTERNATIONAL*
 22 *REGISTRATION.*—If the International Bureau notifies the
 23 United States Patent and Trademark Office of the cancella-
 24 tion of an international registration with respect to some
 25 or all of the goods and services listed in the international
 26 registration, the Director shall cancel any extension of pro-

1 *tection to the United States with respect to such goods and*
 2 *services as of the date on which the international registra-*
 3 *tion was canceled.*

4 “(b) *EFFECT OF FAILURE TO RENEW INTERNATIONAL*
 5 *REGISTRATION.—If the International Bureau does not*
 6 *renew an international registration, the corresponding ex-*
 7 *tension of protection to the United States shall cease to be*
 8 *valid as of the date of the expiration of the international*
 9 *registration.*

10 “(c) *TRANSFORMATION OF AN EXTENSION OF PROTEC-*
 11 *TION INTO A UNITED STATES APPLICATION.—The holder*
 12 *of an international registration canceled in whole or in*
 13 *part by the International Bureau at the request of the office*
 14 *of origin, under article 6(4) of the Madrid Protocol, may*
 15 *file an application, under section 1 or 44 of this Act, for*
 16 *the registration of the same mark for any of the goods and*
 17 *services to which the cancellation applies that were covered*
 18 *by an extension of protection to the United States based*
 19 *on that international registration. Such an application*
 20 *shall be treated as if it had been filed on the international*
 21 *registration date or the date of recordal of the request for*
 22 *extension of protection with the International Bureau,*
 23 *whichever date applies, and, if the extension of protection*
 24 *enjoyed priority under section 67 of this title, shall enjoy*
 25 *the same priority. Such an application shall be entitled to*

1 *the benefits conferred by this subsection only if the applica-*
 2 *tion is filed not later than 3 months after the date on which*
 3 *the international registration was canceled, in whole or in*
 4 *part, and only if the application complies with all the re-*
 5 *quirements of this Act which apply to any application filed*
 6 *pursuant to section 1 or 44.*

7 **“SEC. 71. AFFIDAVITS AND FEES.**

8 “(a) *REQUIRED AFFIDAVITS AND FEES.*—*An extension*
 9 *of protection for which a certificate of extension of protec-*
 10 *tion has been issued under section 69 shall remain in force*
 11 *for the term of the international registration upon which*
 12 *it is based, except that the extension of protection of any*
 13 *mark shall be canceled by the Director—*

14 “(1) *at the end of the 6-year period beginning on*
 15 *the date on which the certificate of extension of pro-*
 16 *tection was issued by the Director, unless within the*
 17 *1-year period preceding the expiration of that 6-year*
 18 *period the holder of the international registration files*
 19 *in the Patent and Trademark Office an affidavit*
 20 *under subsection (b) together with a fee prescribed by*
 21 *the Director; and*

22 “(2) *at the end of the 10-year period beginning*
 23 *on the date on which the certificate of extension of*
 24 *protection was issued by the Director, and at the end*
 25 *of each 10-year period thereafter, unless—*

1 “(A) within the 6-month period preceding
 2 the expiration of such 10-year period the holder
 3 of the international registration files in the
 4 United States Patent and Trademark Office an
 5 affidavit under subsection (b) together with a fee
 6 prescribed by the Director; or

7 “(B) within 3 months after the expiration
 8 of such 10-year period, the holder of the inter-
 9 national registration files in the Patent and
 10 Trademark Office an affidavit under subsection
 11 (b) together with the fee described in subpara-
 12 graph (A) and the surcharge prescribed by the
 13 Director.

14 “(b) CONTENTS OF AFFIDAVIT.—The affidavit referred
 15 to in subsection (a) shall set forth those goods or services
 16 recited in the extension of protection on or in connection
 17 with which the mark is in use in commerce and the holder
 18 of the international registration shall attach to the affidavit
 19 a specimen or facsimile showing the current use of the mark
 20 in commerce, or shall set forth that any nonuse is due to
 21 special circumstances which excuse such nonuse and is not
 22 due to any intention to abandon the mark. Special notice
 23 of the requirement for such affidavit shall be attached to
 24 each certificate of extension of protection.

1 “(c) *NOTIFICATION.*—*The Director shall notify the*
 2 *holder of the international registration who files 1 of the*
 3 *affidavits of the Director’s acceptance or refusal thereof and,*
 4 *in case of a refusal, the reasons therefor.*

5 “(d) *SERVICE OF NOTICE OR PROCESS.*—*The holder*
 6 *of the international registration of the mark may designate,*
 7 *by a document filed in the United States Patent and Trade-*
 8 *mark Office, the name and address of a person residing in*
 9 *the United States on whom notices or process in proceedings*
 10 *affecting the mark may be served. Such notices or process*
 11 *may be served upon the person so designated by leaving*
 12 *with that person, or mailing to that person, a copy thereof*
 13 *at the address specified in the last designation so filed. If*
 14 *the person designated cannot be found at the address given*
 15 *in the last designation, or if the holder does not designate*
 16 *by a document filed in the United States Patent and Trade-*
 17 *mark Office the name and address of a person residing in*
 18 *the United States for service of notices or process in pro-*
 19 *ceedings affecting the mark, the notice or process may be*
 20 *served on the Director.*

21 **“SEC. 72. ASSIGNMENT OF AN EXTENSION OF PROTECTION.**

22 *“An extension of protection may be assigned, together*
 23 *with the goodwill associated with the mark, only to a person*
 24 *who is a national of, is domiciled in, or has a bona fide*
 25 *and effective industrial or commercial establishment either*

1 *in a country that is a Contracting Party or in a country*
 2 *that is a member of an intergovernmental organization that*
 3 *is a Contracting Party.*

4 **“SEC. 73. INCONTESTABILITY.**

5 *“The period of continuous use prescribed under section*
 6 *15 for a mark covered by an extension of protection issued*
 7 *under this title may begin no earlier than the date on which*
 8 *the Director issues the certificate of the extension of protec-*
 9 *tion under section 69, except as provided in section 74.*

10 **“SEC. 74. RIGHTS OF EXTENSION OF PROTECTION.**

11 *“When a United States registration and a subse-*
 12 *quently issued certificate of extension of protection to the*
 13 *United States are owned by the same person, identify the*
 14 *same mark, and list the same goods or services, the exten-*
 15 *sion of protection shall have the same rights that accrued*
 16 *to the registration prior to issuance of the certificate of ex-*
 17 *tension of protection.”.*

18 **SEC. 3. EFFECTIVE DATE.**

19 *This Act and the amendments made by this Act shall*
 20 *take effect on the later of—*

- 21 *(1) the date on which the Madrid Protocol (as*
 22 *defined in section 60 of the Trademark Act of 1946)*
 23 *enters into force with respect to the United States; or*
 24 *(2) the date occurring 1 year after the date of en-*
 25 *actment of this Act.*

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107TH CONGRESS
1ST SESSION

S. 407

[Report No. 107-46]

A BILL

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

JULY 25, 2001

Reported with an amendment